

ADMINISTRATIVE PANEL DECISION

Elsevier Inc. v. Whois Privacy Corp. / duncan wang / Timothy Sumer
Case No. D2022-0829

1. The Parties

The Complainant is Elsevier Inc., United States of America (“United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., United States.

The Respondents are Whois Privacy Corp., Bahamas / duncan wang, United States / Timothy Sumer, United States (hereinafter “the Respondents”).

2. The Domain Name and Registrar

The disputed domain names <hesi-cat-test-bank.com> and <hesi-testbank.com> (the “Disputed Domain Names”) are registered with Internet Domain Service BS Corp (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 9, 2022. On March 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On March 14, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrants and contact information for the Disputed Domain Names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 2022, providing the registrants and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint in order to consolidate the Respondents. The Complainant filed an amended Complaint on March 22, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondents of the Complaint, and the proceedings commenced on March 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 18, 2022. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on April 29, 2022.

The Center appointed Lynda M. Braun as the sole panelist in this matter on May 17, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant provides exams and other study materials to help prepare student nurses for their professional licensure exam as a result of its acquisition in 2006 of the United States company, Health Education Systems Inc. (the "Complainant's predecessor").¹ The Complainant also acquired the trademarks owned by the Complainant's predecessor, for example, among others: HESI, United States Registration No. 3,424,996, registered on May 13, 2008, in international classes 35, 41 and 42. The Complainant also claims common law trademark rights in the HESI Mark, as its first use in commerce was January 31, 1990. The foregoing trademarks will hereinafter be referred to as the "HESI Mark".

As a result of the Complainant's and the Complainant's predecessor's long-term and continuous use of the HESI Mark in commerce, the trademark has come to embody goodwill in the marketplace and serve as a source identifier that consumers recognize as belonging to the Complainant.

In addition, the Complainant's exam questions, which are computerized and administered online, are copyright-protected works for which the Complainant has sought and received United States copyright registrations. The Complainant holds over 100 United States copyright registrations for HESI-related copyright protected works.

The Disputed Domain Name <hesi-testbank.com> was registered on August 10, 2016, and the Disputed Domain Name <hesi-cat-test-bank.com> was registered on September 4, 2018, 8 and 10 years, respectively, after the Complainant registered the HESI Mark. The Disputed Domain Names resolve to the Respondents' websites that feature use of the HESI Mark for the sale of HESI exam questions from previous exams. The Respondents state on their websites that the questions were acquired by taking screenshots during actual exams for use in connection with exam preparation. The Respondents also claim that the displayed questions are authentic, and the resolving website at the <hesi-cat-testbank.com> Disputed Domain Name contains hyperlinks that direct visitors to the resolving website at the <hesi-testbank.com> Disputed Domain Name that displays the infringing screenshots that the Respondents used to create the infringing test banks.

5. Parties' Contentions

A. Complainant

The following are the Complainant's contentions:

- the consolidation of the Respondents is appropriate in this proceeding since the Complaint relates to two Disputed Domain Names and the Disputed Domain Names, and corresponding websites, are subject to common control.
- the Disputed Domain Names are confusingly similar to the Complainant's HESI Mark;
- the Respondents have no rights or legitimate interests in respect of the Disputed Domain Names;
- the Disputed Domain Names were registered and are being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Names from the Respondents to the

¹ The exams and exam questions are, therefore, referred to informally as the "Hesi" exams.

Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondents

The Respondents did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1 Preliminary Issue: Consolidation of the Respondents

The Complainant has requested the consolidation of the Respondents in this proceeding. Pursuant to paragraph 3(c) of the Rules, "[t]he complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder." Where a complaint is filed against multiple respondents, UDRP panels look at whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.2. Procedural efficiency would also underpin panel consideration of such a consolidation scenario. See *Speedo Holdings B.V. v. Programmer, Miss Kathy Beckerson, John Smitt, Matthew Simmons*, WIPO Case No. [D2010-0281](#).

Here, the Complainant contends that the Disputed Domain names, while seemingly registered by two separate individuals, are actually registered by and under the common control of the Respondents and thus, consolidation is warranted. First, while the Disputed Domain Names were registered approximately 2 years apart, both were registered with the same Registrar. Second, the <hesi-cat-testbank.com> Disputed Domain Name resolves to a website that contains hyperlinks that direct visitors to the website hosted at the <hesi-testbank.com> Disputed Domain Name. In addition, both websites share the same favicon.² Third, the Disputed Domain Names target the Complainant's HESI Mark. Finally, the Panel notes that the Respondents have not challenged the Complainant's request for consolidation. Thus, all of the foregoing suggests common control of the Disputed Domain Names and justifies consolidation.

Based on the above, the Panel concludes that it is procedurally efficient, as well as fair and equitable to all Parties, for the Disputed Domain Names to be dealt with by means of a single Complaint. The Panel accordingly grants the Complainant's request for consolidation.

6.2 Substantive Issues

In order for the Complainant to prevail and have the Disputed Domain Names transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

This element consists of two parts: first, does the Complainant have rights in a relevant trademark and, second, are the Disputed Domain Names identical or confusingly similar to that trademark. The Panel concludes that the Disputed Domain Names are confusingly similar to the HESI Mark as set forth below.

² A favicon is a shortcut icon, website icon, tab icon, URL icon, or bookmark icon, associated with a particular website or web page.

It is uncontroverted that the Complainant has established rights in the HESI Mark based on its years of use plus its registered trademarks for the HESI Mark. The consensus view is that “registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive”. *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondents have not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the HESI Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See [WIPO Overview 3.0](#), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the HESI Mark.

The Disputed Domain Name <hesi-testbank.com> consists of the HESI Mark followed by the term “testbank”, joined by a hyphen, and then followed by the generic Top-Level Domain (“gTLD”) “.com”. The Disputed Domain Name <hesi-cat-test-bank.com> consists of the HESI Mark followed by the terms “cat” (an abbreviation for computerized adaptive testing), “test”, and “bank” both joined by hyphens, and then followed by the gTLD “.com”.

It is well established that a domain name that wholly incorporates a trademark is deemed confusingly similar to that trademark for purposes of the Policy despite the addition of another term or abbreviation. As stated in section 1.8 of [WIPO Overview 3.0](#), “where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element”. For example, numerous UDRP decisions have reiterated that the addition of terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Moreover, it is well recognized that a disputed domain name that incorporates a trademark may be confusingly similar to that trademark for purposes of the Policy despite the addition of a hyphen. The presence or absence of punctuation marks such as hyphens cannot on their own avoid a finding of confusing similarity. See *Six Continents Hotels, Inc. v. Helen Siew*, WIPO Case No. [D2004-0656](#).

Finally, the addition of a gTLD such as “.com” in a domain name is technically required. Thus, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#); and [WIPO Overview 3.0](#), section 1.11. Thus, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant’s HESI Mark.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

B. Rights or Legitimate Interests

Under the Policy, a complainant is required to make out a *prima facie* case that a respondent lacks rights or legitimate interests in the domain name at issue. Once such a *prima facie* case is made, the respondent carries the burden of demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1. In this case, the Panel finds that the Complainant has made out a *prima facie* case. In particular, the Respondents have not submitted any arguments or evidence to rebut the Complainant’s *prima facie* case and there is no evidence in the record that the Respondents are in any way associated with the Complainant.

Moreover, the Complainant has not authorized, licensed, or otherwise permitted the Respondents to use its HESI Mark in the Disputed Domain Names. There is also no evidence that the Respondents are commonly known by the Disputed Domain Names or by any name similar to them, nor have the Respondents made any demonstrable preparations to use the Disputed Domain Names in connection with a *bona fide* offering of goods or services. Based on the Respondents’ use of the Disputed Domain Names to resolve to websites

which feature unauthorized use of the HESI Mark in connection with an offering for sale of what appear to be authentic HESI exam questions, which Respondents purportedly obtained by taking screenshots of exam questions from prior examinations, the Panel finds that the Respondents are not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Names. In addition, the Panel notes that the Complainant's HESI exam questions are protected by copyright law. Such unauthorized and infringing use of the Complainant's exam questions in connection with the operation of the Disputed Domain Names can never provide the Respondents with any rights or legitimate interests in the Disputed Domain Names for purpose of the Policy. See [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent.").

In sum, the Panel finds that the Complainant has established an un rebutted *prima facie* case that the Respondents lack rights or legitimate interests in the Disputed Domain Names.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainants.

C. Registered and Used in Bad Faith

The Panel finds that, based on the record, the Complainant has demonstrated the existence of the Respondents' bad faith pursuant to paragraph 4(b) of the Policy as set forth below.

First, based on the circumstances here, the Panel concludes that the Respondents registered and are using the Disputed Domain Names in bad faith in an attempt to attract Internet users to the Respondents' websites by creating a likelihood of confusion with the Complainant's HESI Mark as to the source, sponsorship, affiliation or endorsement of the Disputed Domain Names' resolving websites. The Respondents' registration and use of the Disputed Domain Names indicate that such registration and use have been done for the specific purpose of trading on the name and reputation of the Complainant and its HESI Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Second, the registration of a domain name that reproduces a trademark in its entirety (being identical or confusingly similar to such trademark), along with terms clearly associated to the trademark or its holder, by an individual or entity that has no relationship to that mark, without any reasonable explanation on the motives for the registration, may be suggestive of opportunistic bad faith. See *Ebay Inc. v. Wangming*, WIPO Case No. [D2006-1107](#); *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. The Polygenix Group Co.*, WIPO Case No. [D2000-0163](#).

Third, the Complainant registered and used the HESI Mark for approximately 26 years before the Respondent registered the <hesi-testbank.com> Disputed Domain Name, and 28 years before the Respondent registered the <hesi-cat-test-bank.com> Disputed Domain Name. Further, the Complainant obtained its federal trademark registrations for the HESI Mark 8 and 10 years, respectively, prior to the Respondents' registration of the Disputed Domain Names. It is therefore implausible that the Respondents were not aware of the HESI Mark when they registered the Disputed Domain Names. The Panel therefore finds that the Respondents knew of the Complainant and the Complainant's prior existing rights in the HESI Mark when the Respondents registered the Disputed Domain Names, as evidenced by the Respondents' use of the Disputed Domain Names to sell HESI exam questions that infringed the Complainant's HESI Mark and its copyright-protected HESI exam questions, demonstrating the Respondents' bad faith.

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Names <hesi-cat-test-bank.com> and <hesi-testbank.com> be transferred to the Complainant.

Lynda M. Braun

Sole Panelist

Date: May 31, 2022